



1674

1634

Docket No. 65503-B/JPW/FHB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Elena Feinstein and Orna Mor
Serial No.: 09/825,682 Examiner: D. Johannsen
Filed : April 4, 2001 Group Art Unit: 1634
For : SEQUENCES CHARACTERISTIC OF BLADDER CANCER

1185 Avenue of the Americas
New York, New York 10036
March 24, 2003

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMMUNICATION IN RESPONSE TO FEBRUARY 25, 2003 OFFICE ACTION

This Communication is submitted in response to the Office Action issued by the U.S. Patent and Trademark Office on February 25, 2003 in connection with the above-identified application. A response to the February 25, 2003 Office Action is due March 25, 2003. Accordingly this Amendment is being timely filed.

Restriction Requirement

In the February 25, 2003 Office Action, the Examiner required the election of an additional SEQ ID NO. in addition to the previously elected SEQ ID NOS. 56 and 57.

In response, applicants elect, with traverse, the polynucleotide which is SEQ ID NO. 41.

Applicants: Elena Feinstein and Orna Mor
Serial No.: 09/825,682
Filed: April 4, 2001
Page 2

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application.

Under MPEP § 803, there are two criteria for a proper restriction requirement: 1) the invention must be independent or distinct, and 2) there must be a serious burden on the Examiner if restriction is required. MPEP §803 unambiguously provides that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction is not required between all SEQ ID NOS. because a search of the prior art relevant to any of the SEQ ID NOS. would necessarily turn up the prior art relevant to the claims of the SEQ ID NOS., and vice versa because all of the SEQ ID NOS. are detected in the claimed method for diagnosing bladder cancer. Since there is no burden on the Examiner to examine all SEQ ID NOS. together in the subject application, it is submitted that the Examiner must examine the entire application on the merits.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

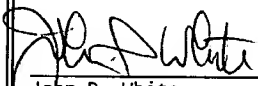
Applicants: Elena Feinstein and Orna Mor
Serial No.: 09/825,682
Filed: April 4, 2001
Page 3

No fee is deemed necessary in connection with the filing of this Communication in Response to February 25, 2003 Office Action. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Attorney for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231	
	3/24/03
John P. White Reg. No. 28,678	Date